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## CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:  
Date: 24 May 2006 Name: C. Noel Kaman, Reg. No. 51,857 Signature: C. Noel Kaman

BRINKS  
HOFFER  
GILSON  
& LIONE

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Filvaroff, et al.Appln. No.: 09/944,884Filed: August 31, 2001For: SECRETED AND TRANSMEMBRANE  
POLYPEPTIDES AND NUCLEIC ACIDS  
ENCODING THE SAMEExaminer: Ruixiang LiArt Unit: 1646Attorney Docket No: 10466/134 (P2548P1C15)

Mail Stop Patent Ext.  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

## TRANSMITTAL

Sir:

## Attached is/are:

- ☒ Application for Reconsideration of Patent Term Adjustment Pursuant to 37 C.F.R. Section 1.705(b) with Exhibit A (Patent Term Adjustment History).
- ☒ Return Receipt Postcard

## Fee calculation:

- ☐ No additional fee is required.
- ☐ Small Entity.
- ☐ An extension fee in an amount of \$\_\_\_\_\_ for a \_\_\_\_\_-month extension of time under 37 C.F.R. § 1.136(a).
- ☐ A petition or processing fee in an amount of \$\_\_\_\_\_ under 37 C.F.R. § 1.17(\_\_\_\_\_).
- ☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			x 100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+\$360=	
					Total	\$		Total	\$

## Fee payment:

- ☒ A check in the amount of \$200 is enclosed.
- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$\_\_\_\_\_. A copy of this Transmittal is enclosed for this purpose.
- ☐ Payment by credit card in the amount of \$\_\_\_\_\_ (Form PTO-2038 is attached).
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

24 May 2006  
Date

C. Noel Kaman  
C. Noel Kaman (Reg. No. 51,857)

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Mail Stop Patent Ext  
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May 24, 2006  
Date of Deposit

C. Noel Kaman  
Signature



Our Case No. **10466/134**  
**P2548P1C15**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

**Filvaroff et al.**

U.S. Patent Application Serial No. **09/944,884**

Mailing Date of Notice of Allowance : **7/14/04**

Filing Date: **August 31, 2001**

Title: **SECRETED AND TRANSMEMBRANE  
POLYPEPTIDES AND NUCLEIC ACIDS  
ENCODING THE SAME**

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)  
) Examiner: **Ruixiang Li**  
)  
) Group Art Unit No. **1646**  
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**APPLICATION FOR RECONSIDERATION OF**  
**PATENT TERM ADJUSTMENT**  
**PURSUANT TO 37 C.F.R. § 1.705(b)**

Mail Stop Patent Ext  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

05/31/2006 YPOLITE2 00000003 09944884

Reconsideration of the patent term adjustment under 35 U.S.C. § 154(b) is requested. 200.00 OP

(1) The fee required as set forth in 37 C.F.R. § 1.18(e) is attached herewith.

**Patent No. 7,018,837**

**Date Filed: Aug. 31, 2001**

**Mail Date of Notice of Allowance: July 14, 2004**

(2) A statement of the facts involved:

- (i) According to the Issue Notification received March 14, 2006, the term of adjustment for U.S. Patent No. 7,018,837 is **534** days. Correction of the patent term adjustment to add an additional **277** days to the patent term is respectfully requested. Thus, Applicants respectfully submit that the proper total patent term adjustment for this patent is **811** days.

The provisions of 37 C.F.R. § 1.702(a)(1)(2) provide the basis for term adjustment of **284** days as set forth in the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).

The provisions of 37 C.F.R. § 1.702(a)(6) provide the basis for **417** days of term adjustment as explained below.

The provisions of 37 C.F.R. § 1.702 (b) provide the basis for **157** days of term adjustment as explained below.

The above-identified days must be decreased by any applicant delay pursuant to 37 C.F.R. § 1.704. As discussed below, Applicants are assessed **47** days of delay. Therefore, the proper calculation for determining the number of days of patent term adjustment to be awarded in this case is as follows: **(284 + 417 + 157) – 47 = 811**, as explained below.

- (ii) The relevant dates, as specified in 37 C.F.R. §§ 1.703(a), for which an adjustment is awarded in the Notice of Allowance and Issue Fee Due are as follows:

**Patent No. 7,018,837**

**Date Filed: Aug. 31, 2001**

**Mail Date of Notice of Allowance: July 14, 2004**

a) The period of adjustment under 37 C.F.R. § 1.703(a)(1) is the number of days, if any, in the period beginning on the day ("the fourteen month date") after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a) of fulfilled the requirements of 35 U.S.C. § 371 (the fourteen-month date) and ending on the date of mailing of either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151, whichever occurs first.

1. The present application was filed on **August 31, 2001**. The fourteen-month date determined pursuant to 37 C.F.R. § 1.703(a)(1) is **October 31, 2002**.

2. The first notification under either 35 U.S.C. §§ 132 or 151 was not mailed until **August 11, 2003**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).

3. Thus, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A), under 37 C.F.R. § 1.702(a)(1), Applicants are entitled to **284** days of patent term extension.

(iii) The relevant dates, as specified in 37 C.F.R. §§ 1.703(a)(6), for which an adjustment is sought are as follows:

a) The period of adjustment under 37 C.F.R. § 1.703(a)(6) is the number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was

paid (the "four month date") and all outstanding requirements were satisfied and ending on the date a patent was issued.

1. The issue fee payment was verified on **October 4, 2004** as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A). The four month date determined pursuant to 37 C.F.R. § 1.703(b) is **February 4, 2005**.
2. The patent issued on **March 28, 2006**.
3. Therefore, Applicants are entitled to an additional **417** days of patent term extension.

(iv) The relevant dates, as specified in 37 C.F.R. § 1.703 (b), for which an adjustment is sought are as follows:

- a) The period of adjustment under 37 C.F.R. § 1.703 (b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date (the three year date) on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application (the "three year date") and ending on the date a patent was issued. This period does not include any days due to a request for continued examination, a declaration of interference, suspension of prosecution due to an interference, maintaining the application in a sealed condition, application of a secrecy order, or time spent appealing a final rejection to the Board of Patent Appeals and Interferences.

**Patent No. 7,018,837**  
**Date Filed: Aug. 31, 2001**  
**Mail Date of Notice of Allowance: July 14, 2004**

1. The application was filed on **August 31, 2001**.  
Therefore, the three year date is **August 31, 2004**.
  2. The application issued as U.S. Patent No. 7,018,837 on **March 28, 2006**. The issue fee payment in this case was verified on **October 4, 2004**. Therefore, to avoid overlapping delay calculations, the time period from four months after payment of the issue fee (February 4, 2005) until issuance of the patent is calculated under 37 C.F.R. § 1.702(a)(6) and is not accounted for under this calculation. Thus, the period for adjustment under 37 C.F.R. § 1.702(b) is from **August 31, 2004** to **February 5, 2005**, which is **157** days.
- (v) U.S. Patent Application Serial No. 09/945,584 is not subject to any terminal disclaimer.
- (vi) Circumstances during the prosecution of the application resulting in the patent that constituted a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704(b) include the following:
- a) The Office mailed a First Non-Final Rejection on **August 11, 2003**. Applicants mailed an Amendment and Response on November 11, 2003, which was filed at the Office on **November 14, 2003**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A). Any response filed after the date that is three months after the date a rejection is mailed is subject to the provisions of 37 C.F.R. § 1.704(b). Indeed, the period of adjustment set forth in § 1.703

shall be reduced by the number of days, if any beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying Applicant of the rejection and ending on the first day the reply is filed. Therefore, the adjustment set forth in § 1.703 must be reduced **3** days based on this transaction.

- b) The Office mailed a Final Rejection on **February 11, 2004**. Applicants mailed an Amendment and Response on April 11, 2004, which was filed at the Office on **April 15, 2004**, as evidence by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A). Because the Amendment and Response were submitted within two-months of mailing of the final rejection, the Examiner was required to respond with a Notice of Allowance or an Advisory Action. On **May 6, 2004** the Office mailed an Advisory Action. Applicants submitted an Amendment and Response to the Advisory Action on **June 24, 2004**, which was filed the same day. Any response filed after the date that is three months after the date a rejection is mailed is subject to the provisions of 37 C.F.R. § 1.704(b). Indeed, the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying Applicant of the rejection and ending on the first day the reply is filed. Therefore, the adjustment set forth in § 1.703 must be reduced **44** days based on this transaction.

- c) Therefore, under the provisions of 37 C.F.R. § 1.704, the adjustment set forth in § 1.703 must be reduced by a total of **47** days.
- d) The PAIR Patent Term Adjustment History indicates that Applicants are charged with an additional **120** days of delay based on receipt of a Miscellaneous Incoming Letter dated **October 4, 2004**. It appears that these additional **120** days of delay are in error. Specifically, the "Miscellaneous Incoming Letter" was a communication to the Examiner, in response to the Examiner's request in the Notice of Allowance for a new declaration from Dan L. Eaton. The communication to the Examiner was submitted along with payment of the issue fee, and stated:

"In the Notice of Allowance and Issue Fee(s) Due mailed 7/14/04, the Examiner requested that a substituted oath of declaration be submitted because of the date of signature of Dan L. Eaton was missing. On 9/9/04 Applicants filed a Request to Correct Inventorship pursuant to 37 C.F.R. § 1.48(b) by deleting Dan L. Eaton as an inventor. Thus, Applicants have rendered the Examiner's request moot."

Therefore, the "Miscellaneous Incoming Letter" was submitted in response to an express request of the Examiner. Pursuant to 37 C.F.R. § 1.704(c)(8), which provides that applicants should not be charged with delay when submitting a paper in response to an express request of the examiner, Applicants should not be charged with any delay as a result of the "Miscellaneous Incoming Letter" filed October 4, 2004.




Patent No. 7,018,837  
Date Filed: Aug. 31, 2001  
Mail Date of Notice of Allowance: July 14, 2004

- (3) Total patent term adjustment - For the present application, the total patent term adjustment under 37 C.F.R. § 1.703(f) is the period of adjustment under 37 C.F.R. § 1.703 reduced by the reduction under 37 C.F.R. § 1.704. The total adjustment is thus **284** days + **417** days + **157** days - **47** days = **811** days, not **534** days as calculated by the Office.

Applicants respectfully request reconsideration of the patent term adjustment for this patent. Office personnel are invited to contact the undersigned Attorney for Applicants via telephone if such communication would expedite this request.

Respectfully submitted,



C. Noel Kaman  
Registration No. 51,857  
Attorney for Applicants

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CHICAGO, ILLINOIS 60610  
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09/944,884

# NUCLEIC ACIDS ENCODING SECRETED POLYPEPTIDES THAT STIMULATE RELEASE OF PROTEOGLYCAN FROM CARTILAGE



Application Data	Transaction History	Image File Wrapper	Patent Term Adjustments	Continuity Data	Published Documents	Fees	Publication Dates	Address & Attorney/Agent
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## Patent Term Adjustment

Filing or 371(c) Date:	08-31-2001	USPTO Delay (PTO) Delay (days):	701
Issue Date of Patent:	03-28-2006	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	167
Post-Issue Petitions (days):	+0	Total Patent Term Adjustment (days):	534
USPTO Adjustment(days):	+0	<a href="#">Explanation Of Calculations</a>	

## Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
03-08-2006	PTA 36 Months		
03-28-2006	Patent Issue Date Used in PTA Calculation	417	
02-16-2006	Receipt into Pubs	⬆	
02-15-2006	Dispatch to FDC	⬆	
02-15-2006	Application Is Considered Ready for Issue	⬆	
10-04-2004	Issue Fee Payment Verified	⬆	
10-04-2004	Miscellaneous Incoming Letter		120
02-08-2006	Correspondence Address Change		⬆
02-08-2006	Receipt into Pubs		⬆
01-20-2006	Receipt into Pubs		⬆
01-13-2006	Mail Miscellaneous Communication to Applicant		⬆
01-12-2006	Miscellaneous Communication to Applicant - No Action Count		
11-17-2005	Pubs Case Remand to TC		
09-23-2005	TC Return to Pubs		
09-12-2005	Pubs Case Remand to TC		
05-17-2005	Receipt into Pubs		
05-06-2005	Receipt into Pubs		
09-13-2004	Rule 47 / 48 Correction of Inventorship Papers Filed		
04-26-2005	Correspondence Address Change		
04-26-2005	Change in Power of Attorney (May Include Associate POA)		
04-22-2005	Receipt into Pubs		
12-06-2004	Workflow - Query Request - Finish		
11-08-2004	Workflow - Query Request - Begin		
10-15-2004	Receipt into Pubs		
09-30-2004	Issue Fee Payment Received		

09-13-2004	Workflow incoming petition IFW	
09-08-2004	Workflow - Query Request - Begin	
08-16-2004	Receipt into Pubs	
08-04-2004	Sequence Forwarded to Pubs on Tape	
07-30-2004	Workflow - File Sent to Contractor	
07-14-2004	Mail Notice of Allowance	
07-13-2004	Notice of Allowance Data Verification Completed	
07-01-2004	Date Forwarded to Examiner	
06-24-2004	Amendment after Final Rejection	44
06-24-2004	Request for Extension of Time - Granted	⬆
05-06-2004	Mail Advisory Action (PTOL - 303)	⬆
05-05-2004	Advisory Action (PTOL-303)	⬆
04-20-2004	Date Forwarded to Examiner	⬆
04-15-2004	Amendment after Final Rejection	⬆
04-15-2004	Workflow incoming amendment IFW	⬆
02-11-2004	Mail Final Rejection (PTOL - 326)	⬆
02-03-2004	Final Rejection	
12-03-2003	IFW Amended case processing Complete	
11-14-2003	Information Disclosure Statement (IDS) Filed	
11-14-2003	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received	
12-03-2003	Date Forwarded to Examiner	
11-14-2003	Response after Non-Final Action	3
08-11-2003	Mail Non-Final Rejection	284
08-11-2003	Non-Final Rejection	⬆
09-03-2002	Preliminary Amendment	⬆
07-29-2003	Correspondence Address Change	⬆
07-29-2003	Correspondence Address Change	⬆
07-29-2003	Correspondence Address Change	⬆
05-15-2003	Case Docketed to Examiner in GAU	⬆
12-20-2002	Case Docketed to Examiner in GAU	⬆
04-29-2002	Information Disclosure Statement (IDS) Filed	⬆
04-03-2002	Case Docketed to Examiner in GAU	⬆
03-27-2002	X-Pre-Legal Complete New Case	⬆
03-27-2002	Case Docketed to Examiner in GAU	⬆
03-27-2002	X-Pre-Legal Complete Amended Case	⬆
08-31-2001	Preliminary Amendment	⬆
08-31-2001	Preliminary Amendment	⬆
01-09-2002	CRF Is Good Technically / Entered into Database	⬆
01-09-2002	Application Dispatched from OIPE	⬆

01-08-2002	Application Is Now Complete	↑
08-31-2001	CRF Disk Has Been Received by Preexam / Group / PCT	↑
09-17-2001	IFW Scan & PACR Auto Security Review	↑
08-31-2001	Initial Exam Team nn	↑

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*If you need help:*

- *Call the Patent Electronic Business Center at (866) 217-9197 (toll free) or e-mail [EBC@uspto.gov](mailto:EBC@uspto.gov) for specific questions about Patent Application Information Retrieval (PAIR).*
- *Send general questions about USPTO programs to the [USPTO Contact Center \(UCC\)](#).*
- *If you experience technical difficulties or problems with this application, please report them via e-mail to [Electronic Business Support](#) or call 1 800-786-9199.*